



PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Shelton, R. H.

Serial No.: 09/025,279

Filed: February 18, 1998

For: **STANDING ORDER DATABASE SEARCH
SYSTEM AND METHOD FOR INTERNET
APPLICATION**

Confirmation No.:

Group Art Unit: 2162

Examiner: Jean B. Fleurantin

Docket No. 50128-1010

DECLARATION OF ROBERT H. SHELTON

I, Robert H. Shelton, inventor of record in the above matter hereby declare as follows:

1. My name is Robert H. Shelton. I am over 21 years old, and am fully competent to make this declaration. I have personal knowledge of the matters set forth herein and know them to be true and correct.
2. I am the sole inventor of United States Patent Application Serial No. 09/025,279, entitled "Standing Order Database Search System and Method for Intranet and Internet Application" (the "'279 application") and a Director and Executive Officer of Allcare Health Management System, Inc. ("Allcare"), a Delaware corporation based in Fort Worth, Texas. Allcare is the owner, by assignment, of all rights, title and interest in and to the '279 application. I submit this declaration in support of Allcare's "Petition under 37 C.F.R. § 1.183" to obtain priority to the provisional application Serial No. 60/037,869.
3. The '279 application originated from provisional application Serial No. 60/037,869 (the "'869 provisional application") that, through my legal counsel, I filed with the United States Patent and Trademark Office ("USPTO") on February 17, 1997. A true and correct copy of the provisional application cover sheet is attached hereto as Exhibit E-1. As shown thereon, the '869 provisional application was dated and signed by my legal counsel, John L. Sigalos, Esq.
4. In anticipation of submission of the '869 provisional application, a "Verified Statement Claiming Small Entity Status" was prepared by Mr. Sigalos. I signed and returned the

original to Mr. Sigalos via Federal Express from Irvine, California on February 12, 1997, prior to submission of the '869 provisional application. A true and correct copy of the "Verified Statement Claiming Small Entity Status" is attached hereto as Exhibit A-1. A true and correct copy of an American Express credit card receipt indicating the Federal Express delivery charge is attached hereto as Exhibit A-2.

5. On February 12, 1997, I sent an e-mail message to John P. Fanning, staff coordinator of the National Committee on Vital and Health Statistics (NCVHS) Subcommittee on Privacy and Confidentiality concerning a series of hearings beginning on February 19, 1997. Believing that the contents of the '869 provisional application would be relevant to the committee's deliberations and knowing that the '869 provisional application had not been filed, I asked if there would be a way "that our commercial interests can be protected and the public good achieved by temporarily holding the content of any writings we submit 'confidential between us and the Subcommittee' for several months' time until we complete the preparation and filing of the appropriate patent applications." A true and correct copy of the e-mail to Mr. Fanning is attached hereto as Exhibit C.
6. In response to being asked by Mr. Sigalos to confirm that there were no co-inventors to be submitted with the '869 provisional application, I reported by e-mail on February 14, 1997 that I had confirmed sole inventorship prior to filing. A true and correct copy of the e-mail to Mr. Sigalos is attached hereto as Exhibit D.
7. On February 17, 1997, Mr. Sigalos sent a letter confirming filing of the '869 provisional application, including a copy of the '869 provisional application. A true and correct copy of the cover letter from Mr. Sigalos is attached hereto as Exhibit E-2. To the best of my recollection and belief, I requested Mr. Sigalos to send the letter and application using my Federal Express account, which was billed directly to my American Express account.
8. On March 1, 1997, Mr. Sigalos submitted a billing statement to Allcare for services rendered during the month of February. A true and correct copy of the billing statement is attached hereto as Exhibit G.
9. Shortly after filing the '869 provisional application, I was informed by Mr. Sigalos that there was an error shown on the filing receipt of the '869 provisional application. Accordingly, I am aware that on March 31, 1997, Mr. Sigalos filed with the USPTO on

my behalf a request for a corrected filing date for the '869 provisional application. A true and correct copy of the "Request for Corrected Original Application Filing Receipt" is attached hereto as Exhibit H-1.

10. Inasmuch as it was clear, based upon my review of the pertinent documents and personal knowledge of the facts surrounding them, that the error in the date shown on the provisional application filing receipt had not been made by me or my counsel, I was confident that it would eventually be fixed by the USPTO in the normal course. Mr. Sigalos had prosecuted several earlier patent applications on my behalf and based upon my experience in working with him on these earlier applications, I had personal knowledge of the fact that he was conscientious and very knowledgeable concerning such matters. Further, it was and is my understanding that Mr. Sigalos was formerly Chief Patent Counsel for The Borden Company, where he worked for ten years; Resident Partner of the Washington, D.C. office of Pennie & Edmonds, a major patent law firm, where he worked for approximately eight years; and the name partner of a Dallas-based patent law firm, Sigalos & Levine, for over fifteen years. Accordingly, when Mr. Sigalos assured me that the error on the provisional application filing receipt would be eventually corrected prior to the issuance of a patent, I saw no reason to question his judgment.
11. Subsequent to filing the '869 provisional application, I actively participated with Mr. Sigalos and a second patent attorney, Andrew M. Hassell, Esq., in finalizing the '279 application. Mr. Hassell had also worked with Mr. Sigalos and myself in prosecuting several earlier applications, and based upon my experience in working with him on these earlier patents, I had personal knowledge of the fact that he was uncommonly disciplined, exceedingly diligent and very knowledgeable about such matters. Further, it was and is my understanding that Mr. Hassell was formerly a patent attorney with Bell Telephone Laboratories, where he worked for five years, and Manager of International Patents at Texas Instruments, where he worked for more than twenty years.
12. At all times during the preparation of the '279 application, Mr. Sigalos, Mr. Hassell and I were conscious of the requirement that such application needed to be filed on or before the one year anniversary of the '869 provisional application – namely no later than February 17, 1998 – in order to obtain the benefit of the February 17, 1997 filing date. There can be no question that at all times our objective was to retain the February 17,

1997 priority date for the '279 application. In support of this assertion, attached hereto as Exhibits L-1 and L-2 are true and correct copies of two email messages that evidence the recognition of the importance of this deadline date and the intention of strictly complying with such deadline. Exhibit L-1 is an email message that Mr. Sigalos sent to me on January 9, 1998, to "ensure timely filing" and in which he writes that the application based on the '869 provisional application "... must be filed by February 17, 1998." Exhibit L-2 is another email message, dated February 12, 1998, which was sent by Mr. Sigalos to Mr. Hassell, Mr. Conner (the President of Allcare) and myself, and in which he writes: "Please call me . . . so we can arrange to discuss the application (*sic.*) and get it on file by Feb. 17."

13. In accordance with this clear recognition of the importance that the application be timely filed, it was and is my understanding and belief that Mr. Sigalos personally deposited the '279 application in an Express Mail collection box located in the lobby of his office building, Carrillon Towers at 13601 Preston Road, Dallas, Texas on February 17, 1998. A true and correct copy of the transmittal letter for such application filing is attached hereto as Exhibit M. As shown on Exhibit M, the transmittal of the '279 application was dated and signed by Mr. Sigalos on February 17, 1998.
14. Shortly after filing the '279 application, I was informed by Mr. Sigalos that he had received the customer copy for the Express Mail filing from the U.S. Postal Service, and had noticed that it showed the package as having not been scanned into the system until 1:56 a.m. on February 18, 1998 despite the fact that he had placed the package into the dedicated collection box before the last pick up time of 5:00PM on February 17, 1998. Moreover, Mr. Sigalos informed me that the filing receipt for the application contained two errors. First, he indicated to me that the filing receipt, a true and correct copy of which is attached hereto as Exhibit Q-2, indicated the date of the '869 provisional application as being February 17, 1996 (whereas the correct date was 1997). Second, he indicated that the filing receipt showed the filing date of the '279 application as having been February 18, 1998 (whereas the correct date was February 17). Mr. Sigalos informed me that he would promptly correct these errors, first by contacting the U.S. Postal Service ("USPS"), and then by filing the appropriate papers with the USPTO.

15. In this regard, it was and is my understanding that Mr. Sigalos promptly contacted the USPS as he indicated he would be doing; and that on March 19, 1998, he received from the USPS an apology letter, explaining that "although [the application] was deposited on [February] 17th, it was not scanned into [the] system until February 18, 1998, when it was processed at the Airport Mail Center" I am aware of the distance between Mr. Sigalos' office building in North Dallas and the airport, and know that it would be virtually impossible for the USPS to have scanned the package into the system at the airport at 1:56AM unless it was picked up sometime before midnight from the collection box where Mr. Sigalos deposited it.
16. Based upon the U.S. Postal Service letter confirming that the package was deposited into their box on February 17, 1998 and his own declaration concerning what transpired (which tracked precisely my understanding based on our earlier discussions), I am aware that on June 10, 1998, Mr. Sigalos filed with the USPTO a "Petition Under 37 CFR 1.182" requesting that the corrected filing date – namely February 17, 1998 – be given to the '279 application. In addition, Mr. Sigalos requested that the corrected filing date – namely February 17, 1997 – be given to the '869 provisional application. A true and correct copy of this Petition is attached hereto as Exhibit R-1.
17. As had been the case with the earlier error concerning the provisional application filing date, it was clear based upon my review of the pertinent documents and my personal knowledge of the facts surrounding them that the error in the date shown on the application filing receipt had not been made either by me or my counsel. Accordingly, when Mr. Sigalos assured me that these errors on the application filing receipt would be eventually corrected prior to the issuance of a patent, I saw no reason to question his judgment and was confident he was taking the proper steps and that these matters – like the earlier error – would eventually be fixed by the USPTO in the normal course.
18. During the course of prosecuting the '279 application, Mr. Sigalos' youngest daughter, who was going through a divorce at the time, was diagnosed as having terminal cancer, went through extensive chemotherapy and subsequently died, leaving an 11-year old daughter (*i.e.*, granddaughter to Mr. Sigalos), a home to sell and other affairs to resolve. Understandably, this was an extremely distressful period and painful experience for Mr. Sigalos, who spent considerable time attending to his daughter and caring for his

granddaughter. Moreover, following his child's death, Mr. Sigalos went through an arduous and bitter custody battle with his former son-in-law to assure visitation rights with respect to his granddaughter. Given the amount of attention that these events were taking and the obvious physical and emotional toll they were extracting, I suggested that Mr. Hassell assume primary responsibility for the file shortly after her death. To the best of my recollection, at about that time I signed a Power of Attorney vesting in Mr. Hassell the authority to act on my behalf with the USPTO in the continued prosecution of the '279 application. It is my understanding that the first Power of Attorney that I signed in favor of Mr. Hassell was either never received by or lost at the USPTO, and for this reason, I executed a second Power of Attorney on November 27, 2002. This document was filed again with the USPTO in order to assure that all correspondence went to Mr. Hassell rather than to Mr. Sigalos. It was my perception that this change in lead counsel came as a relief to Mr. Sigalos, who remained involved only peripherally as a periodic advisor and friend. It was and is my understanding that Mr. Sigalos turned over everything to Mr. Hassell except for the pending matter of correcting the application filing date given his intimate familiarity with the underlying facts of that issue and the then still pending Petition.

19. Following a lengthy appeals process (in which coincidentally the USPTO twice either lost or erroneously recorded documents that were timely filed in the case, inadvertently resulting in considerable additional delays), on March 30, 2005, the Board of Patent Appeals and Interferences rendered its decision on appeal, reversing the Examiner's earlier rejections. Thereafter, on May 23, 2005, the Examiner issued a Notice of Allowability for all 81 claims in the case. Moreover, given that the delays in prosecution were clearly beyond the control of my counsel or myself, the USPTO *sua sponte* granted a patent term extension under 35 U.S.C. 154(b) for an additional 1207 days.
20. Upon receipt of the Notice of Allowability, I requested that all of the materials concerning the prosecution history be finalized in anticipation of preparing corrected drawings and forwarding the issuance fee to the USPTO. A true and correct copy of the Notice of Allowance is attached hereto as Exhibit X. I also again raised the question about the appropriate filing date and asked that this matter be resolved inasmuch as, to the best of my knowledge, we had yet to receive any response whatsoever to the petition

filed by Mr. Sigalos on June 10, 1998, respecting the need to correct the filing date given to the application. It was in the foregoing context that, for the first time in June, 2005, I learned that the USPTO had previously denied the Petition and enumerated therein the additional information that it would need to consider it favorably.

21. I have read the declaration prepared by Mr. Sigalos concerning the circumstances surrounding his having failed to address the PTO action respecting this Petition and, moreover, his having failed to provide copies of the dismissals of the petitions to either Mr. Hassell, myself or anyone else at Allcare. I am certain that, if these materials had been provided to any of us by Mr. Sigalos, we would have timely and fully responded to them, just as our record has shown we have consistently done during the more than eight years in which the '279 application has been pending. However, given the number of inadvertent delays and errors that occurred that were absolutely no fault either of my counsel or myself, it never occurred to me that the oversight might have been by my counsel. Moreover, even with the benefit of having 20/20 hindsight, I can honestly say that I don't know what more Allcare or I could have done to avoid this oversight having transpired.
22. In light of all the foregoing circumstances, I believe it would be proper and equitable to grant the request to accord the '869 provisional application an effective filing date of February 17, 1997, the '279 application an effective filing date of February 17, 1998, and the '279 application priority of the '869 provisional application.
23. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

DATED on this the 28th day of July 2005.


Robert H. Shelton